

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 11, 2003. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 7, 9 and 13 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102

Claims 1-20 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,061,668 issued to John Anthony Sharrow (hereafter "Sharrow"). Applicants respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the Sharrow reference cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because Sharrow does not show all the elements of the present Claims.

Sharrow discloses an "integrated electronic system consisting of a network of appliances and machines, ..., or other equipment ***controlled from a central computer***". (emphasis added). According to Sharrow, "the controller in each appliance or machine incorporates a suitable interface for the network link, and its software is modified as required to implement the network communication interface and protocol, and ***to enable the central management computer 10 to control its operation***". (emphasis added). "Also required are software changes that incorporate the ability to communicate with the central management computer via the network interface, that implement a unique identification code for the appliance or machine, ***that request and require activation by the central management computer prior to running any operation cycles***, and that add a number of additional, related

features". (emphasis added). The related features of Sharrow include the incorporation of an idle mode "so that the appliance or machine *can be restarted, by a command from the central management computer*"; "the incorporation of self-diagnostics which can *detect and report malfunctions* via the network to the central management computer ... [and which] can also be invoked from the central management to allow maintenance personnel to *diagnose and troubleshoot* reported problems", etc. (emphasis added).

Applicants' Claim 1 recites "[a]n apparatus for managing a field asset comprising", among other elements, a "program of instructions operable to independently correct at least one field asset error condition and further operable to package uncorrected error conditions for transmission". As mentioned above, Sharrow does not disclose a field management apparatus capable of correcting error conditions on a field asset which the apparatus is monitoring, let alone independently pursuing correction of a field asset error condition. Further, as Sharrow does not contemplate enabling the field asset management apparatus to correct error conditions on its associated field apparatus, recall that Sharrow only discloses detecting, reporting, diagnosing and troubleshooting field asset malfunctions, Sharrow cannot anticipate packaging uncorrected error conditions. Sharrow simply reports malfunctions. Accordingly, Applicants respectfully assert that Sharrow fails to anticipate each and every element of Applicants' Claim 1 and request that the Examiner reconsider the rejection to Claim 1, withdraw the rejection and allow Claim 1.

Claims 2-6 depend from and provide further patentable limitation to allowable Claim 1. As such, Applicants' respectfully request that the Examiner reconsider the rejections to Claims 2-6, withdraw the rejections and allow Claims 2-6.

At one point in the office action, the Examiner asserts that Claims 7-12 are rejected under 35 U.S.C. §102(b) as being anticipated by Sharrow. However, the Examiner gives no treatment to Claims 7-12 in light of Sharrow under 35 U.S.C. §102(b) and instead treats Claims 7-12 under 35 U.S.C. §103(a), discussed below. Applicants presume that the inclusion of Claims 7-12 in the paragraph of the office action rejecting claims under 35

U.S.C. § 102(b) was an accidental oversight and that the Examiner intended to treat Claims 7-12 only under 35 U.S.C. § 103(a).

Applicants' Claim 13 recites "[a] method for monitoring the operating status of a field asset comprising", among other operations, "identifying whether an error condition present on the field asset is correctable by the monitoring device" and "automatically initiating a correction sequence, to be performed by the monitoring device, designed to correct at least one error condition identified as correctable by the monitoring device". As mentioned above, the device of Sharrow merely detects and reports malfunctions independently. The device of Sharrow is further limited in that it is disclosed to diagnose and troubleshoot malfunctions only upon the control from the central management computer and by maintenance personnel. As such, Sharrow does not anticipate "identifying whether an error condition present on the field asset is correctable by the monitoring device" and "automatically initiating a correction sequence, to be performed by the monitoring device, designed to correct at least one error condition identified as correctable by the monitoring device" as claimed in Applicants' Claim 13. Accordingly, Applicants respectfully request that the Examiner reconsider the rejection to Claim 13, withdraw the rejection and allow Claim 13.

Claims 14-20 depend from and provide further patentable limitations to allowable Claim 13. As such, Applicants' respectfully request that the Examiner reconsider the rejections to Claims 14-20, withdraw the rejections and allow Claims 14-20.

Rejections under 35 U.S.C. §103

Claims 5, 7-12, and 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sharrow in view of U.S. Patent 6,385,772 issued to Jonathan D. Courtney (hereafter "Courtney"). Applicants respectfully traverse.

A finding of obviousness under 35 U.S.C. §103(a) requires a demonstration of the scope and content of the prior art, the level of ordinary skill in the art, differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the

time the invention was made. *Graham v. Deere*, 383 U.S. 1 (1996). The relevant inquiry is whether the prior art both suggests the invention and provides one of ordinary skill in the art with a reasonable expectation that the suggestion would work. *In re O'Farrell*, 853 F.2d 1549, 7 USPQ2d 1673 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In determining whether a claimed invention is obvious in light of a combination of references, the court must be vigilant not to allow hindsight to cloud the question. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) (citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997)). To prevent such "hindsight invalidation," courts require that there be some teaching, suggestion, or reason to combine cited references that are alleged to render the patent claim obvious. *McGinley*, 262 F.3d at 1351. Whether such a motivation to combine prior art references has been demonstrated is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000).

Courtney discloses a monitoring system in which an image from a video camera can be viewed at a remote location. The Courtney system detects the occurrence of an event of interest in the monitored area and transmits, to a portable unit, through a wireless communication link, an indication of the occurrence of that event.

Applicants' Claim 7 recites a "system for the Internet enabled management of a field asset comprising", among other elements, a "monitoring device including a program of instructions storable in the memory and executable in the processor, the program of instructions operable to initiate a sequence of instructions designed to correct at least one error condition in response to a determination that the at least one error condition is addressable by the monitoring device". Alone or in combination, Sharrow and Courtney fail to disclose, teach or otherwise suggest a "monitoring device including a program of instructions storable in the memory and executable in the processor, the program of instructions operable to initiate a sequence of instructions designed to correct at least one

error condition in response to a determination that the at least one error condition is addressable by the monitoring device". As mentioned above, the apparatus of Sharrow is operable only to detect and report malfunctions and, acting upon instructions from maintenance personnel and via a central management computer, to diagnose and troubleshoot malfunctions. Sharrow does not disclose, teach or suggest enabling its device to take independent corrective action. In fact, Sharrow describes requiring its device to take instructions only from the central management computer and operating maintenance personnel in instances other than the detecting and reporting of field asset malfunctions. Even in such event, the Sharrow device is only disclosed to diagnose and troubleshoot by personnel command. The inclusion of the remotely enabled Courtney does nothing to remedy the shortcomings of Sharrow as Sharrow discusses operation of its apparatus from a central management computer. Alone or on combination, Sharrow and Courtney fail to disclose, teach or otherwise suggest a "monitoring device including a program of instructions storable in the memory and executable in the processor, the program of instructions operable to initiate a sequence of instructions designed to correct at least one error condition in response to a determination that the at least one error condition is addressable by the monitoring device" as recited in Applicants' Claim 7. Accordingly, Applicants respectfully request that the Examiner reconsider the rejection to Claim 7, withdraw the rejection and allow Claim 7.

Claims 8-12 depend from and provide further patentable limitation to allowable Claim 7. As such, Applicants' respectfully request that the Examiner reconsider the rejections to Claims 8-12, withdraw the rejections and allow Claims 8-12.

Claim 5 depends from and provides further patentable limitations to allowable Claim 1. As such, Applicants' respectfully request that the Examiner reconsider the rejections to Claims 5, withdraw the rejections and allow Claims 5.

Claims 18-19 depend from and provide further patentable limitations to allowable Claim 13. As such, Applicants' respectfully request that the Examiner reconsider the rejections to Claims 18-19, withdraw the rejections and allow Claims 18-19.

Information Disclosure Statement

Applicants would like to bring to the Examiner's attention that Applicants filed Information Disclosure Statements on January 22, 2002 and June 9, 2003. Applicants respectfully request that the Information Disclosure Statements be considered and cited in the examination of the above-referenced application. Applicants attach a copy of the Information Disclosure Statements and PTO Form 1449s filed January 22, 2002 and June 9, 2003 for the Examiner's convenience and a copy of the postcards receipt evidencing receipt by the Patent Office.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1-20 as amended.

Applicants enclose a Petition for a Two-Month Extension of Time and a check for associated fees in the amount of \$420.00. Applicants believe there are no additional fees due, however, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

ATTORNEY DOCKET
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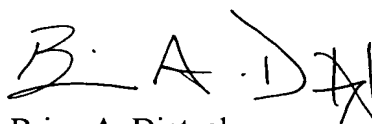
PATENT APPLICATION
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If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2674.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "B. A. Dietzel", with a stylized flourish at the end.

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Date: May 11, 2004